



DOCKET NO.: M0656.70097US00

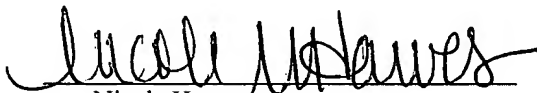
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Alice Y. Ting  
Serial No.: 10/634,740  
Confirmation No.: 8302  
Filed: August 5, 2003  
For: GENETICALLY ENCODED FLUORESCENT REPORTERS OF  
KINASE, METHYLTRANSFERASE, AND ACETYL-TRANSFERASE  
ACTIVITIES  
Examiner: Robert B. Mondesi  
Art Unit: 1653

---

**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the 1<sup>st</sup> day of June, 2005

  
Nicole Hawes

---

**MAIL STOP AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**STATEMENT FILED PURSUANT TO THE DUTY OF  
DISCLOSURE UNDER 37 CFR §§1.56, 1.97 AND 1.98**

Sir:

Pursuant to the duty of disclosure under 37 C.F.R. §§1.56, 1.97 and 1.98, the Applicant requests consideration of this Information Disclosure Statement.

**PART I: Compliance with 37 C.F.R. §1.97**

This Information Disclosure Statement has been filed more than three months after the filing date of this application and after the mailing date of the first Office Action, but before the mailing date of either a final action under 37 C.F.R. §1.113 or a Notice of Allowance under 37 C.F.R. §1.311, or an action that otherwise closes prosecution in this application.

The fee of \$180.00 as set forth in 37 C.F.R. §1.17(p) is enclosed.

901845.1

06/06/2005 SSESHE1 00000011 10634740 180.00 DP  
01 FC:1806

PART II: Information Cited

The Applicant hereby makes of record in the above-identified application the information listed on the attached form PTO-1449 (modified). The order of presentation of the references should not be construed as an indication of the importance of the references.

The Applicant hereby makes the following additional information of record in the above-identified application.

The Applicant would like to bring to the Examiner's attention the following co-pending applications that may contain subject matter related to this application:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Inventor(s)</u>
10/754,911	01/09/2004	Alice Y. Ting
11/040,833	01/20/2005	Alice Y. Ting et al.

PART III: Remarks

Documents cited anywhere in the Information Disclosure Statement are enclosed unless otherwise indicated. It is respectfully requested that:

1. The Examiner consider completely the cited information, along with any other information, in reaching a determination concerning the patentability of the present claims;
2. The enclosed form PTO-1449 be signed by the Examiner to evidence that the cited information has been fully considered by the Patent and Trademark Office during the examination of this application;
3. The citations for the information be printed on any patent which issues from this application.

By submitting this Information Disclosure Statement, the Applicant makes no representation that a search has been performed, of the extent of any search performed, or that more relevant information does not exist.

Serial No.: 10/634,740  
Conf. No.: 8302

- 3 -

Art Unit: 1653

By submitting this Information Disclosure Statement, the Applicant makes no representation that the information cited in the Statement is, or is considered to be, material to patentability as defined in 37 C.F.R. §1.56(b).

By submitting this Information Disclosure Statement, the Applicant makes no representation that the information cited in the Statement is, or is considered to be, in fact, prior art as defined by 35 U.S.C. §102.

Notwithstanding any statements by the Applicant, the Examiner is urged to form his own conclusion regarding the relevance of the cited information.

An early and favorable action is hereby requested.

Respectfully submitted,  
*Alice Y. Ting, Applicant*

By:



Maria A. Trevisan, Reg. No. 48,207  
Wolf, Greenfield & Sacks, P.C.  
600 Atlantic Avenue  
Boston, Massachusetts 02210-2206  
Telephone: (617) 646-8000

Docket No.: M0656.70097US00  
Date: June 1, 2005  
xNDDx



FORM PTO-1449/A and 12 (Modified)

# **INFORMATION DISCLOSURE STATEMENT BY APPLICANT**

APPLICATION NO.: 10/634,740      ATTY. DOCKET NO.: M0656.70097US00  
 FILING DATE: August 5, 2003      CONFIRMATION NO.: 8302  
 APPLICANT: Alice Y. Ting  
 GROUP ART UNIT: 1653      EXAMINER: Robert B. Mondesi

Sheet 1 of 2

## **U.S. PATENT DOCUMENTS**

Examiner's Initials	Cite No.	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication or of issue of Cited Document MM-DD-YYYY
		Number	Kind Code		
	A1	2002/0019002	A1	Griffiths	02/14/2002

## **FOREIGN PATENT DOCUMENTS**

Examiner's Initials	Cite No.	Foreign Patent Document			Name of Patentee or Applicant of Cited Document (not necessary)	Date of Publication of Cited Document MM-DD-YYYY	Translation (Y/N)
		Office/ Country	Number	Kind Code			
	B4	WO	02/066656	A2	MAX-PLANK-GESELLSCHAFT ZUR FOERDERUNG DER WISSENSCHAFTEN E.V.	08/29/2002	
	B5	WO	02/079391	A2	CYTOPRINT, INC.	10/10/2002	

## **OTHER ART — NON PATENT LITERATURE DOCUMENTS**

Examiner's Initials	Cite No	Include name of the author (in CAPITAL LETTERS) title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, relevant page(s), volume-issue number(s), publisher, city and/or country where published.	Translation (Y/N)	
	C33	ADAMS, S. <i>et al</i> , "Fluorescence ratio imaging of cyclic AMP in single cells," <i>Nature</i> 349: 694-697, 1991		
	C34	AITKEN, A. <i>et al</i> , "14-3-3 proteins: biological function and domain structure," <i>Biochemical Society Transactions</i> , 605-611, Received 3 March 1995		
	C35	BALDWIN, T. <i>et al</i> , "Cloning and Expression of the <i>luxY</i> Gene from <i>Vibrio fischeri</i> Strain Y-1 in <i>Escherichia coli</i> and Complete Amino Acid Sequence of the Yellow Fluorescent Protein," <i>Biochemistry</i> 29: 5509-5515, 1990		
	C36	CERVONI, N. <i>et al</i> , "Demethylase Activity Is Directed by Histone Acetylation*," <i>Journal of Biological Chemistry</i> 276(44): 40778-70787, 2001		
	C37	CHEN, I. <i>et al</i> , "Site-specific labeling of cell surface proteins with biophysical probes using biotin ligase," <i>Nature Methods</i> 2(2): 99-104, 2005		
	C38	CUBITT, A. <i>et al</i> , "Understanding, improving and using green fluorescent proteins," <i>TECHNIQUES</i> TIBS 20: 448-455, 1995		
	C39	GONZÁLEZ, J. <i>et al</i> , "Voltage Sensing by Fluorescence Resonance Energy Transfer in Single Cells," <i>Biophysical Journal</i> 69: 1272-1280, 1995		
	C40	HEIM, R. <i>et al</i> , "Engineering green fluorescent protein for improved brightness, longer wavelengths and fluorescence resonance energy transfer," <i>Current Biology</i> 6: 178-182, 1996		
	C41	HEIM, R. <i>et al</i> , "Wavelength mutations and posttranslational autooxidation of green fluorescent protein," <i>Proc. Natl. Acad. Sci. USA</i> 91: 12501-12504, 1994		
	C42	HERMAN, B. "Resonance Transfer Microscopy," <i>Methods In Cell Biology, Chapter 8</i> Vol. 30: 219-243, 1989		
	C43	HUSTON, J. <i>et al</i> , "Protein engineering of antibody binding sites: Recovery of specific activity in an anti-digoxin single-chain Fv analogue produced in <i>Escherichia coli</i> ," <i>Proc. Natl. Acad. Sci. USA</i> 85: 5879-5883, 1988		
	C44	LEVINE, L. <i>et al</i> , "Isolation and Characterization of a Photoprotein, "Phialidin," and A Spectally Unique Green-Fluorescent Protein from the Bioluminescent Jellyfish <i>Phialidium Gregarium</i> *, " <i>Comp. Biochem. Physiol.</i> 72B: 77-85, 1982		

FORM PTO-1449/A and B (Modified)  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>				APPLICATION NO.: 10/634,740	ATTY. DOCKET NO.: M0656.70097US00
				FILING DATE: August 5, 2003	CONFIRMATION NO.: 8302
				APPLICANT: Alice Y. Ting	
				GROUP ART UNIT: 1653	EXAMINER: Robert B. Mondesi
Sheet	2	of	2		

**OTHER ART — NON PATENT LITERATURE DOCUMENTS**

Examiner's Initials	Cite No	Include name of the author (in CAPITAL LETTERS) title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, relevant page(s), volume-issue number(s), publisher, city and/or country where published.	Translation (Y/N)
	C45	LI, L. <i>et al</i> , "Continuous Fluorescence Assay of Phytochrome Assembly <i>in Vitro</i> ," <i>Biochemistry</i> 34: 7923-7930, 1995	
	C46	MEIJSING, S. <i>et al</i> , "The silencing complex SAS-I links histone acetylation to the assembly of repressed chromatin by CAF-I and Asf1 in <i>Saccharomyces cerevisiae</i> ," <i>Genes &amp; Development</i> 15: 3169-3182, 2001	
	C47	NEWTON, D. <i>et al</i> , "Angiogenin Single-Chain Immunofusions: Influence of Peptide Liners and Spacers between Fusion Protein Domains," <i>Biochemistry</i> 35: 545-553, 1996	
	C48	NORRIS, B. <i>et al</i> , "Nucleotide sequence of a cDNA clone encoding the precursor of the peridinin-chlorophyll <i>a</i> -binding protein from the dinoflagellate <i>Symbiodinium</i> sp.," <i>Plant Molecular Biology</i> 24: 673-677, 1994	
	C49	PRASHER, D. <i>et al</i> , "Primary structure of the <i>Aequorea victoria</i> green-fluorescent protein," <i>Gene</i> 111: 229-233, 1992	
	C50	RUNDLETT, S. <i>et al</i> , "HDA1 and RPD3 are members of distinct yeast histone deacetylase complexes that regulate silencing and transcription," <i>Proc. Natl. Acad. Sci. USA</i> 93: 14503-14508, 1986	
	C51	SINGAL, R. <i>et al</i> , "Methylation of $\alpha$ -type embryonic globin gene $\alpha\pi$ represses transcription in primary erythroid cells," <i>Blood</i> 2002 (abstract)	
	C52	TSUKAMOTO, T. <i>et al</i> , "Visualization of gene activity in living cells," <i>Nature Cell Biology</i> 2: 871-878, 2000	
	C53	WARD, W. <i>et al</i> , "Spectral Perturbations of the <i>AEQUOREA</i> Green-Fluorescent Protein," <i>Photochem. Photobiol.</i> 35: 803-808, 1982	
	C54	WHITLOW, M. <i>et al</i> , "An improved linker for single-chain Fv with reduced aggregation and enhanced proteolytic stability," <i>Protein Engineering</i> 6(8): 989-995, 1993	
	C55	WILBANKS, S. <i>et al</i> , "Rod Structure of a Phycoerythrin II-containing Phycobilisome," <i>Journal of Biological Chemistry</i> 268(2): 1226-1993, 1993	
	C56	LIN, C. <i>et al</i> , "Genetically Encoded Fluorescent Reporters of Histone Methylation in Living Cells," <i>J. Am. Chem. Soc.</i> , 126:5982-3, 2004	
	C57	LIN, C. <i>et al</i> , "A Genetically Encoded Fluorescent Reporter of Histone Phosphorylation in Living Cells," <i>Angew. Chem Int. Ed.</i> , 43:2940-3, 2004	

EXAMINER:	DATE CONSIDERED:
-----------	------------------

#EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

\*a copy of this reference is not provided as it was previously cited by or submitted to the office in a prior application, Serial No. \_\_, filed \_\_, and relied upon for an earlier filing date under 35 U.S.C. 120 (continuation, continuation-in-part, and divisional applications).

[NOTE - The Office hereby waives the requirement under 37 CFR 1.98 (a)(2)(i) for submitting a copy of each cited U.S. patent and each U.S. patent application publication for all U.S. national patent applications filed after June 30, 2003 and for all international applications that have entered the national stage under 35 USC 371 after June 30, 2003. See 37 CFR 1.491(b). For all patent applications filed on or before June 30, 2003, copies of cited U.S. patents and patent application publications are still required unless an eIDS is filed. Copies of all other patent(s), publication(s), or other information listed must still be provided, even if it was previously submitted to, or cited by, the U.S. Patent Office in an earlier application, unless the earlier application is identified by the IDS and is relied upon for an earlier filing date under 35 U.S.C. §120, and the copy was provided in the earlier application.]